



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/798,116  | 03/10/2004  | Gert Callies         | 10191/3549          | 5929             |
| 26646   | 7590        | 04/03/2006           | EXAMINER            |                  |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      | HEINRICH, SAMUEL M  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |

1725

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**MAILED**

APR 03 2006

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**GROUP 1700**

Application Number: 10/798,116  
Filing Date: March 10, 2004  
Appellant(s): CALLIES ET AL.

**MAILED**

APR 03 2006

**GROUP 1700**

---

Gerard Messina  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 06, 2006 appealing from the Office action mailed April 12, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

Art Unit: 1725

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 11, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP708155670A. See the Abstract and Figure 3. The device can be arranged with an electric field such that the workpiece is either charged positive or negative. The apparatus uses current detectors for operation control.

Claims 9, 11, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP06000684A. See the Abstract and Figures. The device has an electric field which prevents adhesion of scattered particles during laser surface treatment.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 1725

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP408155670A as applied to claim 9 above, and further in view of JP7266073A. The base reference does not describe a magnetic field applied to the point of action on the workpiece. JP7266073A shows well known machining using the magnetic field applied to the point of action. The addition of the magnetic field to the base reference would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the field improves the particle removal action.

#### **(10) Response to Argument**

Applicant's arguments filed January 06, 2006 have been fully considered but they are not persuasive. Applicant argues that the base references, JP '670 and JP '684, disclose the current-voltage source interconnected between two electrodes which is inconsistent with the instant claimed current-voltage source interconnected between one electrode and one workpiece. This argument is not convincing. The connection of one electrode or one wire or other connection means to the workpiece is no different than the instant claimed connection of "interconnected in such a way that the workpiece is positively charged and the electrode is negatively charged." Further, in the absence of a workpiece ("W" in JP '670 or "1" in JP '684) the second electrode would become the "workpiece" during operation of the apparatus.

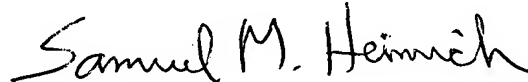
In response to applicant's arguments against the JP '670 and JP '673 references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Samuel M. Heinrich

Conferees:

Patrick J. Ryan, Steven Griffin

